REMARKS

Claim 74 is amended. Claims 1, 8, 14-35 and 60-68 were previously cancelled without prejudice. Claims 2-7, 9-13, 36-59 and 69-94 remain in the application for consideration. In view of the following remarks, Applicant respectfully requests reconsideration and allowance of the subject application.

§101 Rejections

Claims 74-77 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Applicant disagrees with this rejection. Nonetheless, Applicant has amended the claim to recite that the application program resides on a computer-readable media, thereby traversing the Office's rejection.

§ 103 Rejections

Claims 2, 5-7, 9-11, 36-40, 43, 46-48, 50-54, 59, 80, 81, 84-89 and 92-94 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,572,648 to Bibayan in view of U.S. Patent No. 6,563,514 to Samar.

Claims 3-4, 12-13, 41-42, 45, 49, 56-57, 82-83 and 90-91 stand rejected under 35 U.S.C. § 103(a) as being obvious over Bibayan in view of Samar and further in view of U.S. Patent No. 5,742,504 to Meyer et al. (hereinafter "Meyer").

Claim 58 stands rejected under 35 U.S.C. §103(a) as being obvious over Bibayan in view of Samar and further in view of U.S. Patent No. 5,602,996 to Powers et al. (hereinafter "Powers").

Claims 69-79 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,611,840 to Baer et al. (hereinafter "Baer") in view of Meyer and in further view of Bibayan and still further in view of Samar.

Claim 44 stands rejected under 35 U.S.C. § 103(a) as being obvious over Bibayan in view of Samar and in further view of Baer.

Claim 55 stands rejected under 35 U.S.C. § 103(a) as being obvious over Bibayan in view of Samar and in further view of U.S. Patent No. 5,436,637 to Gayraud et al. (hereinafter "Gayraud").

The Claims

Claim 6 recites a method of exposing commands in a software application program comprising:

- determining a user's context within an application program by ascertaining a position of a user's cursor within a document provided by the application program; and
- automatically displaying at least one command on a display for the user based on the user's context, wherein said automatically displaying is accomplished, at least in part, using tree-based visibility expressions, wherein individual expressions define conditions associated with a user's interaction with the document and which are used to ascertain when to display said at least one command.

In making out the rejection of this claim, the Office argues that its subject matter is obvious over Bibayan in view of Samar. Applicant respectfully disagrees and submits that the Office has failed to establish a *prima facie* case of obviousness for at least the two reasons discussed below.

First, the Office has not provided a sufficient motivation to combine these references. The motivation to combine Bibayan with Samar given by the Office is stated as follows: "One would have been motivated to make such a combination because changing of the display based on the user's cursor changes the item of

focus without having to make a selection." Office Action at page 4. However, this statement merely paraphrases the functionality of Samar and does not explain why there exists, if any, sufficient motivation to combine Samar with Bibayan. See Samar at figure 6b and column 4, lines 39-45 (disclosing that "when a pointer or cursor is positioned by a user over an item of interest, and without further interaction from the user, information related to the item of interest is retrieved locally and/or remotely and then presented to the user.")

Based on this stated motivation, it appears that the Office has simply taken a feature from the disclosure of Samar and combined it with Bibayan in an attempt to establish that claim 6 is obvious in view of these references. It is impermissible, however, to use the embodiment claimed by Applicant as an instruction manual or "template" to piece together the teachings of the prior in an attempt to render the claimed embodiment obvious. In re Fritch, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992). This is considered to be a type of hindsight reconstruction, and is an improper application of § 103. Accordingly, the Office has failed to provide a sufficient motivation to combine Bibayan and Samar.

A second reason that the Office has failed to establish a *prima facie* case of obviousness with respect to this claim is that the combination of these references fails to teach all of this claim's recited features. In order to establish that the subject matter of a claim is obvious, the prior art reference (or references when combined) must teach or suggest all the claim limitations. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Specifically, the Office argues that Bibayan teaches the claim feature of (emphasis added):

> wherein said automatically displaying is accomplished, at least in part, using *tree-based visibility expressions*, wherein individual expressions

define conditions associated with a user's interaction with the document and which are used to ascertain when to display said at least one command.

The Office argues that Bibayan discloses this claim feature at figure 5 and at column 5, lines 19-56. A close reading of these sections, however, indicates that figure 5 of Bibayan and the accompanying text merely present a flowchart that details the particular logic involved in the method disclosed by Bibayan. See Bibayan at column 5, lines 16-18. A flowchart cannot be equated with a tree-based visibility expression. Bibayan does not disclose in this section or anywhere else this feature of claim 6. In point of fact, neither Bibayan nor Samar expressly disclose or suggest *any* type of tree-based expression. Accordingly, the combination of Bibayan and Samar fails to teach all of the features of claim 6.

For at least the two reasons discussed above, the Office has failed to establish a *prima facie* case of obviousness with respect to this claim and this claim is allowable.

Claims 2-5, 7 and 9-11 depend from claim 6 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 6, are neither disclosed nor suggested by the reference of record. In addition, to the extent that claim 6 is allowable, the further rejection of claims 3-4 over Bibayan in view of Samar and further in view of Meyer is not seen to add anything of significance.

Claim 12 recites one or more computer-readable media having computer-readable instructions thereon which, when executed by a computer, cause the computer to:

- determine a user's context within an application program;
- automatically display, independent of the user selecting any displayed menu item, at least one command on a display for the user based on the user's context, said at least one command being displayed in a modeless fashion in which the user can continue to work within a document provided by the application program while said at least one command is displayed; and
- automatically remove said at least one command from the user's display responsive to a change in the user's context,
- wherein said automatically display and automatically remove are accomplished, at least in part, using tree-based visibility expressions, wherein individual expressions define conditions associated with a user's interaction with the application and are used to ascertain when to display said at least one command.

In making out the rejection of this claim, the Office argues that its subject matter is obvious over Bibayan in view of Samar and further in view of Meyer. Applicant respectfully disagrees and submits that the Office has failed to establish a *prima facie* case of obviousness for at least the two reasons discussed below.

First, the Office has failed to establish sufficient motivation to combine Bibayan and Meyer. The Office's stated motivation to combine these references is that "having the ability to work within a document while displaying all the toolbar options allows the user to use the toolbar options without obscuring the document." Office Action at pages 15-16. However, it does not appear that Bibayan suffers from any deficiencies that require the addition of this particular feature of Meyer. Nowhere does Bibayan indicate that the display of its toolbars results in its documents being obscured. See, for example, figures 6-8 of Bibayan and the accompanying text at column 5, line 58, through column 6, line 62. These figures clearly illustrate that the application windows disclosed by Bibayan can be displayed simultaneously with the corresponding toolbars without the toolbars obscuring their respective windows. Bibayan does not require the addition of

Meyer in order to achieve this result. Accordingly, the Office has failed to establish sufficient motivation to combine Bibayan and Meyer.

A second reason that the Office has failed to establish a *prima facie* case of obviousness with respect to this claim is that the combination of these references fails to teach all of this claim's recited features. The Office argues that Bibayan discloses a tree-based visibility expression and that Samar discloses a tree structure. Office Action at page 16. However, as discussed above, neither Bibayan nor Samar discloses or suggests the feature of a tree-based visibility expression. In point of fact, neither of these references expressly discloses or suggests *any* type of tree-based expression.

The Office has failed to establish a *prima facie* case of obviousness for at least the reasons discussed above and this claim is allowable.

Claim 13 depends from claim 12 and is allowable as depending from an allowable base claim. This claim is also allowable for its own recited features which, in combination with those recited in claim 12, are neither disclosed nor suggested by the reference of record.

Claim 36 recites a method of exposing commands in a software application program comprising:

- determining a user's context within an application program by evaluating at least portions of one or more expressions, each expression being associated with a context block and defining a condition that describes one or more aspects of a user's interaction with the application program, wherein individual expressions comprise tree-based visibility expressions; and
- automatically displaying, independent of a user selecting any displayed menu item, at least one context block on a display for the user based on the user's context, individual context blocks

containing multiple commands that are possible selections for a user based upon their context.

In making out the rejection of this claim, the Office argues that its subject matter is obvious over Bibayan in view of Samar. Applicant respectfully disagrees and submits that the Office has failed to establish a *prima facie* case of obviousness for at least the reasons discussed below.

First, the Office has failed to establish a sufficient motivation to combine Bibayan and Samar. The Office's stated motivation to combine these references is to "provide[] a more adapted display." Office Action at page 7. Applicant submits that the motivation "to provide a more adapted display" is **too general** because it could cover almost any alteration contemplated of Bibayan. The Office itself has provided specific guidance in the area of § 103 rejections and has stated emphatically that the motivation of *efficiency*, which like the motivation of being *more adapted*, is too general because it could cover almost any alteration contemplated of the primary reference. This guidance can be found at the following URL:

http://www.uspto.gov/web/menu/busmethp/busmeth103rej.htm

See also In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("*particular* findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed")(emphasis added).

Accordingly, the Office has failed to establish sufficient motivation to combine Bibayan and Samar.

A second reason that the Office has failed to establish a *prima facie* case of obviousness with respect to this claim is that the combination of these references fails to teach all of this claim's recited features. As discussed above, neither Bibayan nor Samar discloses or suggests the feature of a tree-based visibility expression. In point of fact, neither of these references expressly discloses or suggests *any* type of tree-based expression.

For at least the reasons discussed above, the Office has failed to establish a *prima facie* case of obviousness with respect to this claim and this claim is allowable.

Claims 37-45 depend from claim 36 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 36, are neither disclosed nor suggested by the reference of record. In addition, to the extent that claim 36 is allowable, the further rejection of claims 41-42 and 45 over Bibayan in view of Samar and further in view of Meyer is not seen to add anything of significance. Finally, to the extent that claim 36 is allowable, the further rejection of claim 44 over Bibayan in view of Samar and further in view of Baer is not seen to add anything of significance.

Claim 46 recites a method of exposing commands in a software application program comprising:

- determining a user's context within an application program without requiring the user to make a menu selection, wherein said determining is accomplished, at least in part, using tree-based visibility expressions, wherein individual tree-based visibility expressions define conditions that describe a user's interactions with said application program;

- based on the user's context, displaying commands that are associated with the context and which can assist the user in accomplishing a task; and
- while the commands are being displayed, enabling the user to select and apply various commands multiple times.

In making out the rejection of this claim, the Office argues that its subject matter is obvious over Bibayan in view of Samar. Applicant respectfully disagrees and submits that the Office has failed to establish a *prima facie* case of obviousness for at least the reasons discussed below.

First, as discussed above, the Office has failed to establish a sufficient motivation to combine. The stated motivation -- to provide a more adapted display -- is simply too general because it could cover almost any alteration contemplated of Bibayan.

The second reason is that the combination of these references fails to teach all of this claim's recited features. As discussed above, neither Bibayan nor Samar discloses or suggests the feature of a tree-based visibility expression.

Accordingly, the Office has failed to establish a *prima facie* case of obviousness for at least the reasons discussed above. This claim is allowable.

Claims 47-59 depend from claim 46 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 46, are neither disclosed nor suggested by the reference of record. In addition, to the extent that claim 46 is allowable, the further rejection of claims 49 and 56-57 over Bibayan in view of Samar and further in view of Meyer is not seen to add anything of significance.

Further, to the extent that claim 46 is allowable, the further rejection of claim 55 over Bibayan in view of Samar and further in view of Gayraud is not

seen to add anything of significance. Finally, to the extent that claim 46 is allowable, the further rejection of claim 58 over Bibayan in view of Samar and further in view of Powers is not seen to add anything of significance.

Claim 69 recites a computing system comprising:

- a single application program configured to provide:
- a single navigable window;
- multiple different functionalities to which the single navigable window can be navigated by a user; and
- at least one context-sensitive command area that is associated with the single navigable window, the single application program being configured to automatically change command sets that are presented to the user within the command area as the user navigates to different functionalities, at least some commands of the command sets being displayable independent of the user selecting any displayed menu item and as a function of one or more tree-based visibility expressions that define conditions that describe a user's interactions with the single application program.

In making out the rejection of this claim, the Office argues that its subject matter is obvious over Baer in view of Meyer and in further view of Bibayan and still further in view of Samar. Applicant respectfully disagrees and submits that the Office has failed to establish a *prima facie* case of obviousness for at least the reasons discussed below.

First, the Office has failed to establish a sufficient motivation to combine Baer, Meyer, Bibayan and Samar. The motivation provided by the Office to combine these references is to "provide[] a more adapted display." Office Action at page 23. However, as discussed above with respect to the combination of Bibayan and Samar, the stated motivation to provide a more adapted display is

simply too general because it could cover almost any alteration contemplated of the cited references.

The second reason is that the combination of these references fails to teach all of this claim's recited features. The Office admits that Baer and Meyer do not specifically teach the tree-based visibility expressions recited in this claim. Office Action at page 22. Applicant agrees. However, the Office then argues that Bibayan and Samar disclose this feature. Applicant respectfully disagrees and submits, as discussed above, that neither Bibayan nor Samar discloses or suggests the feature of a tree-based visibility expression.

Accordingly, the Office has failed to establish a *prima facie* case of obviousness for at least the reasons discussed above. This claim is allowable.

Claims 70-73 depend from claim 69 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 69, are neither disclosed nor suggested by the reference of record.

Claim 74 recites a computing system comprising:

- a single application program configured to:
- display a single navigable window for a user to use in navigating between multiple different functionalities that can be provided by the single application program;
- provide at least one context-sensitive command area that is associated with the single navigable window, the single application program automatically changing command sets that are presented to the user within the command area as the user navigates to different functionalities, at least some commands of the command sets being displayable independent of the user selecting any displayed menu item and as a function of one or more tree-based visibility expressions that define conditions that describe a user's interactions with the single application program; and

- incorporate different functionalities in an extensible manner so that the user can use the single navigable window to navigate to the different incorporated functionalities.

In making out the rejection of this claim, the Office argues that its subject matter is obvious over Baer in view of Meyer and in further view of Bibayan and still further in view of Samar. Applicant respectfully disagrees and submits that the Office has failed to establish a *prima facie* case of obviousness for at least the reasons discussed below.

First, the Office has failed to establish a sufficient motivation to combine Baer, Meyer, Bibayan and Samar. The motivation provided by the Office to combine these references is to "provide[] a more adapted display." Office Action at page 26. However, as discussed above with respect to the combination of Bibayan and Samar, the stated motivation to provide a more adapted display is simply too general because it could cover almost any alteration contemplated of the cited references.

The second reason is that the combination of these references fails to teach all of this claim's recited features. The Office admits that Baer and Meyer do not specifically teach the tree-based visibility expressions recited in this claim. Office Action at page 25. Applicant agrees. However, the Office then argues that Bibayan and Samar disclose this feature. Applicant respectfully disagrees and submits, as discussed above, that neither Bibayan nor Samar discloses or suggests the feature of a tree-based visibility expression.

Accordingly, the Office has failed to establish a *prima facie* case of obviousness for at least the reasons discussed above. This claim is allowable.

Claims 75-77 depend from claim 74 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 74, are neither disclosed nor suggested by the reference of record.

Claim 78 recites a computing method comprising:

- displaying a user interface that comprises a single navigable window that can be navigated between multiple different functionalities that are provided by a single application program;
- receiving user input that indicates selection of a particular functionality;
- responsive to receiving said user input, navigating the single navigable window to the particular selected functionality and displaying in said window indicia of said functionality that can enable a user to accomplish a task associated with the particular selected functionality;
- determining a user's context within the selected functionality using one or more tree-based visibility expressions, wherein individual expressions define conditions associated with a user's interaction with said selected functionality; and
- automatically displaying at least one command for the user based on the user's context independent of the user selecting any displayed menu item.

In making out the rejection of this claim, the Office argues that its subject matter is obvious over Baer in view of Meyer and in further view of Bibayan and still further in view of Samar. Applicant respectfully disagrees and submits that the Office has failed to establish a *prima facie* case of obviousness for at least the reasons discussed below.

First, the Office has failed to establish a sufficient motivation to combine Baer, Meyer, Bibayan and Samar. The motivation provided by the Office to combine these references is to "provide[] a more adapted display." Office Action

at page 28. However, as discussed above with respect to the combination of Bibayan and Samar, the stated motivation to provide a more adapted display is simply too general because it could cover almost any alteration contemplated of the cited references.

The second reason is that the combination of these references fails to teach all of this claim's recited features. The Office admits that Baer and Meyer do not specifically teach the tree-based visibility expressions recited in this claim. Office Action at page 27. Applicant agrees. However, the Office then argues that Bibayan and Samar disclose this feature. Applicant respectfully disagrees and submits, as discussed above, that neither Bibayan nor Samar discloses or suggests the feature of a tree-based visibility expression.

Accordingly, the Office has failed to establish a *prima facie* case of obviousness for at least the reasons discussed above. This claim is allowable.

Claim 79 depends from claim 78 and is allowable as depending from an allowable base claim. This claim is also allowable for its own recited features which, in combination with those recited in claim 78, are neither disclosed nor suggested by the reference of record.

Claim 80 recites a method of exposing commands in a software application program comprising:

- determining a user's context within an application program by ascertaining a user's selection within a document provided by the application program and by using one or more tree-based visibility expressions, wherein individual expressions define conditions associated with a user's interaction with said document; and
- automatically displaying at least one command on a display for the user based on the user's context.

In making out the rejection of this claim, the Office argues that its subject matter is obvious over Bibayan in view of Samar. Applicant respectfully disagrees and submits that the Office has failed to establish a *prima facie* case of obviousness for at least the reasons discussed below.

First, as discussed above, the Office has failed to establish a sufficient motivation to combine. The stated motivation to provide a more adapted display is simply too general because it could cover almost any alteration contemplated of Bibayan.

The second reason is that the combination of these references fails to teach all of this claim's recited features. As discussed above, neither Bibayan nor Samar discloses or suggests the feature of a tree-based visibility expression.

Accordingly, the Office has failed to establish a *prima facie* case of obviousness for at least the reasons discussed above. This claim is allowable.

Claims 81-87 depend from claim 80 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 80, are neither disclosed nor suggested by the reference of record. In addition, to the extent that claim 80 is allowable, the further rejection of claims 82-83 over Bibayan in view of Samar and further in view of Meyer is not seen to add anything of significance.

Claim 88 recites a method of exposing commands in a software application program comprising:

- determining a user's context within an application program using, at least in part, one or more tree-based visibility expressions, wherein individual expressions define conditions associated with a user's interaction with the application program; and

- automatically displaying at least one command on a display for the user based on the user's context, independent of a user selecting any displayed menu item.

In making out the rejection of this claim, the Office argues that its subject matter is obvious over Bibayan in view of Samar. Applicant respectfully disagrees and submits that the Office has failed to establish a *prima facie* case of obviousness for at least the reasons discussed below.

First, as discussed above, the Office has failed to establish a sufficient motivation to combine. The stated motivation to provide a more adapted display is simply too general because it could cover almost any alteration contemplated of Bibayan.

The second reason is that the combination of these references fails to teach all of this claim's recited features. As discussed above, neither Bibayan nor Samar discloses or suggests the feature of a tree-based visibility expression. ·

Accordingly, the Office has failed to establish a *prima facie* case of obviousness for at least the reasons discussed above. This claim is allowable.

Claims 89-94 depend from claim 88 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 88, are neither disclosed nor suggested by the reference of record. In addition, to the extent that claim 88 is allowable, the further rejection of claims 90-91 over Bibayan in view of Samar and further in view of Meyer is not seen to add anything of significance.

Conclusion

All of the claims are in condition for allowance. Accordingly, Applicant requests a Notice of Allowability be issued forthwith. If the Office's next anticipated action is to be anything other than issuance of a Notice of Allowability, Applicant respectfully requests a telephone call for the purpose of scheduling an interview.

Respectfully Submitted,

Dated: 5/1/06

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